

REMARKS

Claims 27-31 have been amended. Claim 32 has been canceled and claims 36 and 37 have been added.

Applicant wishes to thank the Examiner for the courtesies extended to applicant's undersigned attorney in the telephone interview conducted with the Examiner on Tuesday, March 6, 2007. During the interview, applicant discussed with the Examiner proposed amended claims which applicant believed overcame the Examiner's objections and rejections in the pending Action. The Examiner made additional suggestions for clarifying the terms "document number", "case number" and "family" used in the proposed claims and applicant's amended claims as set forth above are believed to have incorporated clarifying language for these terms.

In particular, applicant's amended claims 27-31 and added claims 36 and 37 are supported generally by the description in applicant's specification at pages 45-50 and by applicant's FIGS. 1 and 29-33. To aid the Examiner in understanding the invention, applicant has set forth below a version of amended claim 27 annotated to include the pages and figures in applicant's specification providing support for the recited features.

Claim 27. An information processing system to display
a prior art document relating to a patent application to be or being
prosecuted, comprising:

an input unit (scanner 2103 in FIG. 21, step S2709 in FIG. 27)
configured to input a prior art document of a second patent application
to be or being prosecuted in a second country with a document number,
wherein the document number can be the patent number in the case of an
issued patent and the publication number in the case of a published patent
application (page 47, lines 1-4), and wherein the second patent application
is in a family of a first patent application to be or being prosecuted in a

first country, the family of the first patent application including a group of one or more patent applications each of which having a content substantially equivalent to the content of the first patent application (page 46, lines 9-11);

a server (118 in FIG. 1) configured to store the prior art document of the second patent application with the document number input by said input unit via a network (127 in FIG. 1), wherein the prior art document input by said input unit becomes readable by using the document number;

a display unit (FIG. 29) configured to display a case number being the reference number of a company (2901 in FIG. 29; page 46, lines 4-6) of the first patent application to be or being prosecuted together with both the document number (DOC NO.DE 1200001 of 2905 in Fig.29; page 47, line1) of the prior art of the second patent application and country information (EP, AU of 2903 in Fig. 29; page 46, lines 11-12) of the second patent application on a common screen, the document number of the prior art of the second patent application and the country information of the second patent application being obtained from the server.

As explained to the Examiner during the interview, the system of the invention of amended claim 27 is particularly supported by the description on pages 45-47 of applicant's specification and by FIGS. 1 and 29 of applicant's drawings. The system is directed to problems occurring in a patent application to be or being prosecuted and, in particular, of ensuring that any prior art was properly cited in the application. Specifically, the system of the invention is configured to display a prior art document relating to a patent application to be or being prosecuted. An input unit (scanner 2103 in FIG. 21, step S2709 in FIG. 27) is configured to input a prior art document of a second patent application to be or being prosecuted in a second country with a document number. The document number can be the patent number in the case of an issued patent and the publication number in the case of a published patent application (page 47, lines 1-4). The second patent application is in a family of a first patent application to be or being prosecuted in a first country. The family of the first patent application includes a group of

one or more patent applications each of which having a content substantially equivalent to the content of the first patent application (page 46, lines 9-11).

A server (118 in FIG. 1) is configured to store the prior art document of the second patent application with the document number input by the input unit via a network (127 in FIG. 1). This permits prior art document input to be readable by using the document number;

A display unit (FIG. 29) is configured to display a case number being the reference number of a company (2901 in FIG. 29; page 46, lines 4-6) of the first patent application to be or being prosecuted together with both the document number (DOC NO.DE 1200001 of 2905 in FIG. 29; page 47, line 1) of the prior art of the second patent application and country information (EP, AU of 2903 in FIG. 29; page 46, lines 11-12) of the second patent application on a common screen. The document number of the prior art of the second patent application and the country information of the second patent application are obtained from the server.

Applicant's amended claim 27 as above-described and set forth and likewise applicant's claim 31, and their respective dependent claims 29-30, as also above set forth are believed to now overcome the Examiner's objections and rejections of the claims in the Action. In particular, claim 32 has been canceled, thereby obviating the objection to this claim as informal. Likewise, claims 27 and 31 have now been amended to include hardware, i.e., an input unit, a server and a display unit for performing the recited functions. This inclusion is believed to overcome the Examiner's rejection of claims 27 and 31 under 35 USC § 101 as directed to non-statutory subject matter based on the Examiner's argument that the "system lacks inclusion of the hardware necessary for any of the underlining functionality to be realized."

Additionally, these claims no longer use the terms the “actual document number” and “actual reference number” which the Examiner argued was a basis for rejecting claims 27 and 31 under 35 USC § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim applicant’s invention. In particular, amended claims 27 and 31 now use the term “document number” and further recite that the document number can be the patent number in the case of an issued patent and the publication number in the case of a published patent application. They further use the term “family of a first patent application” and additionally recite that the family of the first patent application includes a group of one or more patent applications each of which having a content substantially equivalent to the content of the first patent application. Finally, the claims recite a “case number” as being the reference number of a company.

Therefore, the terminology of amended claims 27 and 31, and their respective dependent claims, now particularly points out and distinctly claims applicant’s invention, pursuant to the provisions of claims 35 USC § 112, second paragraph.

Applicant further pointed out during the interview that the cited references, i.e., the Lindh publication (US Patent Publication No. US 2002/0022974) and the Rivette, et al. patent (US Patent No. 5,991,751) were both directed to systems for accessing issued patents and not to problems encountered in citing prior art in patent applications to be or being prosecuted. Specifically, it was further pointed out that these references failed to teach or suggest displaying with a case number being a reference number of a company of a first patent application to be or being prosecuted in a first country a prior art document in a second patent application to be or being prosecuted in a second country using the document number of the prior art document and

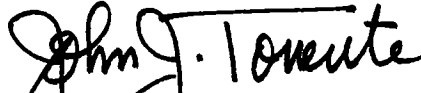
also displaying the country information of the second patent application. In this regard, applicant's have studied carefully the portions of the Lindh publication cited by the Examiner (page 4, paragraphs 0039-0040; pages 1-2, paragraph 0018; page 2, paragraphs 0023-0024; page 3, paragraph 0032; page 2, paragraph 0026; page 3, paragraph 0036; page 2, paragraph 0018), as well as the other passages of the publication, and they fail to teach or suggest this construction. Likewise, the cited portions of the Rivette, et al patent (FIG. 61; FIG. 125; FIG. 13; FIG. 154A; column 49, lines 46-67; column 50, lines 1-64; column 90, lines 51-64; column 117, lines 25-40; FIG 61; column 118, lines 34-41), and the other portions of the patent, fail to teach or suggest such construction.

In view of the above, it is submitted that applicant's claims, as amended, meet all statutory requirements and patentably distinguish over the cited art of record. Accordingly, reconsideration of the claims is respectfully requested.

Dated: March 12, 2007

Respectfully submitted,

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